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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,635	06/29/2001	Tom Grimes	5594	5799
38598	7590	03/22/2005	EXAMINER	
ANDREWS KURTH L.L.P. 1701 PENNSYLVANIA AVENUE, N.W. SUITE 300 WASHINGTON, DC 20006			ZAND, KAMBIZ	
			ART UNIT	PAPER NUMBER
			2132	

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/893,635	GRIMES ET AL.	
	Examiner	Art Unit	
	Kambiz Zand	2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 29 June 2001.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-40 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-7, 10-19, 22-28 and 30-40 is/are rejected.

7) Claim(s) 8,9,20,21 and 29 is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 29 June 2001 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ .

5) Notice of Informal Patent Application (PTO-152)

6) Other: ____ .

03/18/05

DETAILED ACTION

1. **Claims 1-40** have been examined.
2. Priority benefit claimed under Title 35, United States Code, § 119 (e) have been acknowledged.

Claim Objections

3. **Claim 33** is objected to because of the following informalities:

Claim 33: Examiner suggests the followings:

- The phrase “determining if the digital certificate is valid” be re-phrased as “determining if the digital certificate is valid by said DRM server”

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 1-7, 10-19, 22-28 and 30-40** are rejected under 35 U.S.C. 102(e) as being anticipated by Hurtado et al (6,611,812 B2).

As per claims 1, 13, 25 and 33 Hurtado et al (6,611,812 B2) teach a system, a computer-readable medium comprising instructions and a method of digital rights management (DRM) see col.7, lines 20-25; col.9, lines 46-67, comprising the steps of: receiving content at a client computer (see fig.3 and associated text; col.5, lines 59-61), wherein the content is encrypted with an encryption key (see col.5, lines 59-61; fig.3 block 301 and associated text); the client computer requesting the encryption key from a server using a digital certificate (see fig.3, the certification authority site and associated text; col.5, lines 64-67 and col.6, lines 1-14; col.17, lines 21-49), wherein the server is remote from the client computer; the server receiving the request; and determining if the digital certificate is valid (see col.17, lines 23-35; fig.1-3 and associated text). Also see the entire reference for detailed with respect to different embodiments of the above limitations.

As per claims 2, 14, 15 and 34 Hurtado et al (6,611,812 B2) teach the system, the computer-readable medium comprising instructions and the method of claims 1, 13, 14 and 33 respectively, wherein if the digital certificate is valid the method further comprises the steps of: transmitting the encryption key to the client computer; and the client computer decrypting the content with the encryption key (see fig.3 and associated

text; col.17, lines 59-67; col.6, lines 1-14).

As per claims 3, 16, 26 and 35 Hurtado et al (6,611,812 B2) teach the system, the computer-readable medium comprising instructions and the method of claims 2, 13, 25 and 34 respectively, further comprising the steps of: encrypting the encryption key, wherein: the transmitting step transmits the encrypted encryption key to the client computer; and the client computer decrypting the encrypted encryption key (see fig. 1a block 113, 126; fig.fig.3 block 301-303; fig.4 and associated text; col.21, lines 53-59).

As per claims 4, 17 and 36 Hurtado et al (6,611,812 B2) teach the system, the computer-readable medium comprising instructions and the method of claims 3, 16 and 35 respectively, further comprising the step of: determining a hardware profile of the client computer, wherein: the encrypting step encrypts the encryption key with the hardware profile of the client computer (see col.36, lines 63-66; col.37, lines 1-13) and the table on col.37-38).

As per claims 5, 18 and 37 Hurtado et al (6,611,812 B2) teach the system, the computer-readable medium comprising instructions and the method of claims 4, 16 and 36 respectively, wherein: the hardware profile of the client computer is stored and linked with a copy of the digital certificate on the server; and the determining step retrieves the hardware profile that is linked with the copy of the digital certificate (see col.36, lines 63-66; col.37, lines 1-13) and the table on col.37-38).

As per claim 6 Hurtado et al (6,611,812 B2) teach the method of claim 2, wherein encryption key is only stored in volatile memory of the client computer (see col.37-38 where the key stored in the ROM described in the table shown).

As per claims 7, 19, 28 and 38 Hurtado et al (6,611,812 B2) teach the system, the computer-readable medium comprising instructions and the method of claims 1, 13, 25 and 33 respectively, wherein: a first hardware profile of the client computer is stored and linked with a copy of the digital certificate on the server; the requesting step includes transmitting a second hardware profile of the client computer to the server; and the determining step determines whether the second hardware profile is the same as the first hardware profile (see col.36, lines 63-66; col.37, lines 1-13) and the table on col.37-38).

As per claims 10, 22, 30 and 40 Hurtado et al (6,611,812 B2) teach the system, the computer-readable medium comprising instructions and the method of claims 1, 13, 25 and 33 respectively, wherein: the digital certificate includes a certificate serial number; a copy of the digital certificate that includes the certificate serial number is stored on the server; the requesting step includes transmitting the certificate serial number to the server; and the determining step includes retrieving the copy of the digital certificate using the certificate serial number (see col.36-39 where the certification revocation list and other certificate are identifies by their id number and where their expiration are

listed and are used to validate the content).

As per claims 11, 23 and 31 Hurtado et al (6,611,812 B2) teach the system, the computer-readable medium comprising instructions and the method of claims 1, 13 and 25 respectively, wherein the receiving step receives content from a website server (see fig.14 and 15b and associated text).

As per claims 11, 24 and 32 Hurtado et al (6,611,812 B2) teach the system, the computer-readable medium comprising instructions and the method of claims 1, 13 and 25 respectively, wherein the server is a first server and the receiving step receives content from a second server co-located with the first server (see fig.1a and 1b where the content provider server in relation with the web server of fig.1b as the second server receives the content data).

As per claim 27 Hurtado et al (6,611,812 B2) teach the computer-readable medium of claim 26, wherein: the encryption key is encrypted with a hardware profile of the client computer (as applied to claim 36 above); and the decrypting instruction decrypts the encryption key with the hardware profile of the client computer (col.37-38).

As per claim 39 Hurtado et al (6,611,812 B2) teach the computer-readable medium of claim 38, wherein: the digital certificate includes a public key of a public key infrastructure (PKI) key pair; the second hardware profile of the client computer is

encrypted with a random session key; the random session key is encrypted with the public key of the PKI key pair; a copy of the digital certificate including a private key of the PKI key pair is stored on the server; and the determining instruction includes decrypting the random session key with the private key of the PKI key pair (as applied to claims 29 and 9 above since the claim is combination of the referred claims).

Allowable Subject Matter

6. **Claims 8, 9, 20, 21 and 29** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Please see references noted in enclosed PTO-892.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Zand whose telephone number is (571) 272-3811. The examiner can normally reached on Monday-Thursday (8:00-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (571) 272-3799. The fax phone numbers for the organization where this application or proceeding is assigned as

(703) 872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kambiz Zand

03/18/05